



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/753,537      | 01/02/2001  | David L. Multer      | FUSN1-01003US0      | 1714             |

28554 7590 07/29/2005

VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 MARKET STREET, SUITE 540  
SAN FRANCISCO, CA 94105

EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/753,537

Applicant(s)

MULTER ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 80-90, 109-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80-90, 109-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/23/05, 5/25/05
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

5:00

## **DETAILED ACTION**

### **Remarks**

1. The Amendment filed on May 25, 2005 has been received and entered. Claims 90-108 have been cancelled. Therefore, claims 80-90, and 109-116 are pending.
2. The replacement drawing submitted on May 25, 2005 are hereby accepted.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 80-90, and 109-116 are provisionally rejected under the judicially created doctrine of double patenting over claims 80, 82-139 of copending application Serial No. 09/753,643. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

5. Claims 80-90, and 109-116 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of Multer et al. U.S. Patent No. 6,738,789 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claim 34 of Multer et al. '789 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements

perform the same functions as before involves only routine skill in the art. See In re Karlson, 136 USPQ 184.

6. Claims 80-90, and 109-116 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of Multer et al. U.S. Patent No. 6,757,696 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claim 1 of Multer et al.'696 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See In re Karlson, 136 USPQ 184.

7. Claims 80-90, and 109-116 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-69 of Multer et al. U.S. Patent No. 6,694,336 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claim 1 of Multer et al.'336 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See In re Karlson, 136 USPQ 184.

8. Claims 80-90, and 109-116 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of Multer et al. U.S. Patent No. 6,671,757 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claim 24 of Multer et al. '757 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See In re Karlson, 136 USPQ 184.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 80-90, and 109-116 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris U.S. Patent No. 5,574,906 ('Morris').

**Morris** discloses:

As to claim 80,

computer code for comparing at least one file on the personal computer and a record of the file on the computer, and providing binary differencing data between the file and the record of the file; See Abstract; 11:52-67; 12:1-15; and

a transaction generator providing at least one binary difference transaction including said binary differencing data to an output for forwarding to a network coupled server, the server using the binary differencing data to synchronize at least one other network coupled processing device; See Abstract; 11:52-67; 12:1-15; figure 2; 6:50-67.

As to claim 81,

wherein the output is coupled to a network, and the synchronizer is operatively coupled to at least one storage server via the network, the storage server receiving said difference transaction from said synchronizer; See Abstract; 11:52-67; 12:1-15.

As to claim 82,

wherein the synchronizer receives at least one binary difference transaction from the storage server, and further including computer code for applying the received difference transaction to the at least one file on the device; See Abstract; 11:52-67; 12:1-15.

As to claim 83,

wherein the synchronizer includes code for updating the record of the file on the device subsequent to applying the received difference transaction; See Abstract; 11:52-67; 12:1-15.

Art Unit: 2165

As to claim 90,

wherein the computer code for comparing at least one file on the personal computer includes Xdelta; See Abstract; 11:52-67; 12:1-15.

As to claim 109,

computer code for comparing at least one file on a network coupled device in communication with the network coupled server and extracting binary differencing data representing the difference between the file and a record of the file; See Abstract; 11:52-67; 12:1-15; and

a transaction generator providing at least one transaction including said binary differencing data to an output of the network coupled server; See Abstract; 11:52-67; 12:1-15; figure 2.

As to claim 110,

wherein the record of the file is provided on the network coupled device; See Abstract; 11:52-67; 12:1-15.

As to claim 111,

wherein the record of the file is provided on the network coupled server; See Abstract; 11:52-67; 12:1-15.

As to claim 112,



wherein the record of the file is a previous version in time of the file; See Abstract;  
11:52-67; 12:1-15.

As to claim 113

wherein the synchronizer further includes application code to modify a second version of the file by applying said binary differencing data to the second version of the file; See Abstract;  
11:52-67; 12:1-15.

As to claim 114,

wherein the second version of the file is on a second network coupled device; See Abstract; 11:52-67; 12:1-15.

As to claim 115,

wherein the second version of the file is on the network coupled server; See Abstract;  
11:52-67; 12:1-15.

As to claim 116,

at least a first binary differencing engine coupled to a first network coupled device; See Abstract; 11:52-67; 12:1-15;

at least a second binary differencing engine coupled to a second network coupled device;  
See Abstract; 11:52-67; 12:1-15; and

a storage device coupled to the first and the second network coupled devices storing binary differencing data from and outputting binary differencing data to said at least first and second binary differencing engines; See Abstract; 11:52-67; 12:1-15.

As to claim 105,

Morris discloses the claimed invention except for wherein the installation package is accessible via the World Wide Web. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein the installation package is accessible via the World Wide Web that such a modification would enable communicating and loading from anywhere in the world for the internet.

### *Response to Arguments*

11. Applicant's arguments filed on May 25, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that "the provisional double patent rejection is not clear and should be withdrawn" is acknowledged but is not deemed to be persuasive.

The Examiner respectfully disagrees and maintains the double patenting rejection as being of obviousness type.

In response to applicant's argument that "Morris does not disclose delta file is outputted by the server" is acknowledged but is not deemed to be persuasive.

The Examiner maintains that Morris discloses whenever the client detects that a frequently accessed file has been modified, the modified version of the file is differenced against the base version of that file without decompressing the entire base file and a delta file is generated. The delta file is then transmitted to the server to be stored at the server for storage medium to be utilized either immediately or at a later time to update the base version of the modified file on the server (See Abstract).

In response to applicant's argument that "Morris does not disclose a delta file being used to synchronize the changed file to other devices networked to the server" is acknowledged but is not deemed to be persuasive.

The Examiner maintains that the Applicant agrees on page 6 of the response that Morris teaches that the delta is in sync between client and server indicating up-to-date transaction difference as claimed. In column 5, lines 24-35, Morris teaches the client backup program contacts the server backup program which consults its backup catalog to establish the location of the backup copy of the file. It then returns that file across the network to the client computer which in turn makes it available to the user. In column 6, lines 50-67, and column 7, lines 1-13, Morris further discloses when the base file recognized to have been changed at the client, and is then transmitted to the backup server. The server may simply save the new delta and then use it at a later time to modify the compressed base file in the backup subsystem, or may apply it immediately against the base file to create a copy of the new file to the client.

### *Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
July 25, 2005

  
**CHARLES RONES**  
**PRIMARY EXAMINER**